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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/800,299

03/12/2004

James F. McGuckin JR.

1231

8233

7590

12/13/2006

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EXAMINER

EREZO, DARWIN P

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/800,299

Applicant(s)

MCGUCKIN ET AL.

Examiner

Darwin P. Erez

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/10/05, 1/26/05</u> | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u>            |

Continuation of Attachment(s) 6). Other: IDS 8/22/05,9/12/05,10/24/05,11/16/06.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species:

Species I, as shown in Fig. 26, is directed towards a filter having a flexible member that moves from a first retracted position to a second looped position.

Species II, as shown in Fig. 5, is directed towards a filter having an inner filter and an outer filter with a proximal ring.

The species are independent or distinct because the invention as claimed do not overlap in scope, i.e., are mutually exclusive since the flexible member of Species I is not in Species II, while the inner and outer filter of Species II are not in Species I. Furthermore, these features are not mutually exclusive features are not obvious variants of each other, and that the invention as claimed in either Species I and II are not capable of use together.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

2. During a telephone conversation with Neil Gershon on 12/11/06 a provisional election was made with traverse to prosecute the invention of Species I, claims 1-16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17 and 18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Information Disclosure Statement***

4. The information disclosure statements (IDS) submitted on 1/10/05, 1/26/05, 8/22/05, 9/12/05, 10/24/05 and 11/16/06 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6,146,39 to Konya et al.

(claim 1) Fig. 5 of Konya discloses a distal protection device comprising a catheter **12/32** and a flexible member **33** movable from a first retracted position (Fig. 1) to a second looped position (Fig. 5) extending laterally with respect to the catheter such that a first loop opening extends perpendicular to the longitudinal axis of the catheter (see Fig. 5), and filtering material **16** movable from collapsed position to an expanded position.

(claim 2) The flexible material is contained within the catheter in the first position (Fig. 1 or 6).

(claim 3) The catheter **12** and clip **32** are viewed as “the catheter” which includes a side opening where the flexible member extends (Fig. 4).

(claim 4) The flexible member loops in a plane perpendicular to the longitudinal axis of the catheter (Fig. 5).

(claims 5-7) Konya discloses a second loop **30** radially spaced from the first loop, wherein the loops extend in opposite directions approximately 180 degrees apart. (Fig. 5).

(claims 8 and 9) The loops are axially offset with respect to a transverse axis of the catheter.

(claim 10) Actuating member **14** moves the flexible member into a looped position.

(claim 11) Movement of the actuating member to a retracted position would automatically move the filtering material to a collapsed position, as seen in Fig. 1.

(claim 12) See the rejection to claim 3 and the following: wire **33** has a portion that loop distally and a portion that loops proximally.

(claim 13) See the rejection to claim 14.

(claim 14) See the rejection to claim 5.

(claim 15) See the rejection to claim 11 and the following: the loop opening defined by loop **30** or **33** lies in a plane that is non-aligned with the longitudinal axis of the catheter.

(claim 16) See the rejection to claim 3.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erez whose telephone number is (571) 272-4695. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Darwin P. Erez  
Examiner  
Art Unit 3731

de